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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,899	07/21/2003	Matthew J. Newsome	2322-0483CP	7640

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EXAMINER	
LE, UYEN CHAU N	
ART UNIT	**PAPER NUMBER**
2876	

DATE MAILED: 03/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/623,899	NEWSOME ET AL.	
	Examiner	Art Unit	
	Uyen-Chau N. Le	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-20 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-20 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 10/27/03.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because the use of the legal phraseology, "means", line 6, is not permitted. Correction is required. See MPEP § 608.01(b).

Claim Objections

2. Claim 10 is objected to because of the following informalities:

Re claim 20, line 3: Substitutes "instructions;" with -- instructions. --.

Appropriate correction is required.

Obviousness-Type Double Patenting

3. Claims 1 and 10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,595,416) (hereinafter '416).

Although the conflicting claims are not identical, they are not patentably distinct from each other because in claims 1 and 10 of the instant application, Applicants claim a terminal for **adding value** to a plurality of **fare cards**, the terminal comprising: "a patron **display** for displaying **information and instructions** to a patron for adding value to a fare card of the plurality of fare cards"; "at least one **fare card reader** for reading from and writing to the fare card"; "a payment interface means comprising a **debit/credit card reader** for accepting at least one of a credit card and a debit card"; and "a **control and memory assembly**...". The '416

patent discloses a terminal in communication with a transit station controller for **adding value** to **fare cards**, the terminal comprising: "... a patron **display** for displaying **information and instructions** to a patron"; ... " a **fare card entry bezel** for accepting **contact-type smart cards**"; "a **contactless smart card** target and reader"; "a **debit/credit card reader** for providing means of payment using a debit/credit card"; ... "a **control and memory assembly**... ". Although the scope of claims 1 and 10 of the present application and claim 1 of '416 patent are almost identical, the difference between the present claimed invention and the '416 patent is that the present claimed invention is a broader recitation of the '416 patent (e.g., the present claimed invention recites "at least one **fare card reader** for reading from and writing to the fare card, etc." whereby the '416 patent recites "a **fare card entry bezel** for accepting **contact-type smart cards**; a **contactless smart card** target and reader, etc."). Thus, with respect to above discussions, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to use the teaching of claim 1 of '416 patent as a general teaching for having a terminal for **adding value** to **fare cards** with the same functions as claimed by the present application. The instant claims obviously encompass the patented claims and differ only in terminology. To the extent that the instant claim is broaden and therefore generic to the patented claims [species], In re Goodman 29 USPQ 2d 2010 CAFC 1993, states that a generic claim cannot be issued without a terminal disclaimer, if a species claim has been previously been patented.

The obviousness-type double patenting rejection is a judicially established doctrine base upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. In re

Vogel, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R § 1.78(d).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1, 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kiribuchi (JP 09-305,806) in view of Baker et al (US 4,977,502).

Re claim 1: Kiribuchi discloses a terminal for conducting a plurality of cashless transactions for adding value to a plurality of fare cards, the terminal comprising: a patron display 1 for displaying information and instructions to a patron for adding value to a fare card of

the plurality of fare cards; at least one fare card reader [21, 28] for reading from and writing to the fare card (English translation: figs. 2-3; paragraphs [0023-0024]); a payment interface means comprising a debit/credit card reader [2, 22] for accepting at least one of a credit card and a debit card (English translation: figs. 2-3; paragraphs [0025-0027]); and a control and memory assembly 20 comprising: means for controlling the patron display 1; means 31 for communicating with the at least one fare card reader for reading from and writing to the at least one fare card to complete at least one cashless transaction of the plurality of cashless transactions; means 32 for communicating with the payment interface means to obtain debit/credit information (English translation: figs. 2-3; paragraphs [0028-0033]).

Kiribuchi is silent with respect to means for storing a history of the at least one cashless transaction.

Baker et al teaches a magnetic fare card system comprising a microprocessor, which will record the payment of the fare and the amount of the fare for transmission to the fare processor unit 152 (fig. 6; col. 12, lines 24-52).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Baker et al into the system as taught by Kiribuchi in order to provide Kiribuchi with a capability of transaction verification (i.e., via record/history of transactions) in the event of disagreement between passenger and the value of the fare card.

Re claim 10: a plurality of selection buttons 36 adjacent the patron display for selecting options in response to the displayed information and instructions (Baker et al: fig. 1).

Re claim 11: means [28, 12] for issuing a new or recycled fare card (Kiribuchi: English translation; figs. 2-3; paragraph [0032]).

7. Claims 2, 4, 12, 13, 15 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kiribuchi as modified by Baker et al as applied to claim 1 above, and further in view of Aoyanagi et al (JP 05-028,335). The teachings of Kiribuchi as modified by Baker et al have been discussed above.

Re claims 2, 4, 12, 13, 15 and 17-19: Kiribuchi/Baker et al has been discussed above but is silent with respect to the plurality of fare cards comprises contactless smart cards; and the at least one fare card reader comprises: a contactless smart card reader; respectively.

Aoyanagi et al teaches an automatic fare adjustment device comprising a non-contact fare card C, which is read by a non-contact card reader via an installation base 7/antenna 7'; the transit station controller 10 communicates with the non-contact card C for authorizing a transaction value and writing the authorized transaction value to the fare card C utilizing the contactless card reader (English translation: fig. 3; paragraphs [0009-0012].

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Aoyanagi et al into the system as taught by Kiribuchi/Baker et al in order to provide Kiribuchi/Baker et al with universal system which can utilize different types of fare cards (i.e., magnetic or non-contact smart card, etc.). Furthermore, such modification would provide the user the flexibility in choosing a desired fare card (i.e., magnetic or non-contact smart card, etc.) when using public transportation system, and therefore an obvious expedient.

8. Claims 3, 5, 6 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kiribuchi as modified by Baker et al as applied to claim 1 above, and further in view of Drupsteen (US 6,003,776). The teachings of Kiribuchi as modified by Baker et al have been discussed above.

Re claims 3, 5, 6 and 14: Kiribuchi/Baker et al has been discussed above but is silent with respect to the plurality of fare cards comprises contact smart cards; and the at least one fare card reader comprises: a contact smart card reader; respectively.

Drupsteen teaches a contact smart card for storing multiple tickets (fig. 1; col. 2, lines 20-63).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Drupsteen into the system as taught by Kiribuchi/Baker et al in order to provide Kiribuchi/Baker et al with universal system which can utilize different types of fare cards (i.e., magnetic or non-contact smart card, etc.). Furthermore, such modification would provide the user the flexibility in choosing a desired fare card (i.e., magnetic or non-contact smart card, etc.) when using public transportation system, and therefore an obvious expedient.

9. Claims 7, 8 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kiribuchi as modified by Baker et al as applied to claim 1 above, and further in view of Adams (US 5,255,182). The teachings of Kiribuchi as modified by Baker et al have been discussed above.

Re claims 7, 8 and 16: Kiribuchi/Baker et al has been discussed above but is silent with respect to the history of the at least one cashless transaction is uploaded from the control and

memory assembly to the transit station area controller at a pre-determined time, wherein the pre-determined time for uploading the history is after each cashless transaction of the plurality of cashless transactions.

Adams teaches terminal 1 can be programmed to upload transaction data spontaneously after a preset time interval or after a preset number of transactions (i.e., a preset number of transactions can be 1 or after each transaction) (col. 11, lines 6-21).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate teachings of Adams into the system as taught by Kiribuchi/Baker et al in order to provide Kiribuchi/Baker et al with more feasible system in which information data of each transaction can be upload and stored at the server, thus a large capacity memory is not required at each terminal for storing transaction data. Furthermore, such modification would provide the user flexibility in retrieving transaction data from the server/host at any station/terminal via the network system, and therefore an obvious expedient.

10. Claims 9 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kiribuchi as modified by Baker et al as applied to claim 1 above, and further in view of Kutsuzawa et al (US 2001/0056412). The teachings of Kiribuchi as modified by Baker et al have been discussed above.

Re claims 9 and 20: Kiribuchi/Baker et al has been discussed above but is silent with respect to the fare card is a special status fare card, and wherein the control and memory assembly adds value to the special status fare card without obtaining the credit/debit information through the debit/credit card reader.

Kutsuzawa et al teaches a method and system for collecting fee without obtaining credit card information (p. 17, paragraph [0185]); the method and system further applied in transportation ticket (e.g., airplane ticket, etc.) (p. 17, paragraph [0189]).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Kutsuzawa et al into the system as taught by Kiribuchi/Baker et al in order to provide Kiribuchi/Baker et al with an advanced system, in which the fare value can be adjusted/added without requiring an insertion of a credit card by the passenger, thus credit card processing time can be eliminated, and therefore providing a time consumption system.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The patents to Kimata (US 5043561 A); Muraoka (US 5550360 A); Mimata et al (JP 02148290 A); Mitamura (JP 05108929 A); Kawai (JP 06131521 A); Kawai (JP 06131523 A); Watabe et al (JP 2000137840 A); Tsukamoto et al (JP 08045044 A); Takeda et al (JP 10283515 A); Kelly et al (US 6010074 A); Hiroya et al (US 5754654 A); Kimata (EP 361110 A2); Yanagisawa (JP 04181493 A) are cited as of interest and illustrate a similar structure to a system for rapidly dispensing and adding value to fare cards.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 571-272-2397. The examiner can normally be reached on Mon-Fri. 5:30AM-2:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL G. LEE can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Uyen-Chau N. Le
February 24, 2005